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EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
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2123

34

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 34

Application Number: 08/941,832
Filing Date: October 1, 1997
Appellant(s): Chacon

Ronald P. Kananen
For Appellant

EXAMINER'S RESPONSE TO BOARD REMAND

This is in response to the Board's Remand on the appeal. The Board's advice has been carefully considered. Please note that most rejections have been withdrawn, in response to Board's comments. Further note that there are no new grounds of rejection. The status of the claims is as follows:

- all 112(2) rejections are withdrawn.
- the Claims are rejected over prior art (as discussed subsequently). Most art rejections have been withdrawn. Some are withdrawn because they do not map to the claims. Others are

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withdrawn because the Board has indicated that the number of rejections should be reduced. This has been done as requested. However, the Examiner is of the opinion that many of the withdrawn references are cumulative to the remaining applied pieces of prior art. The Examiner will subsequently list the art which is considered cumulative. The Examiner recognizes that the Board's determination applies equally to the art listed as cumulative.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

A correct statement of the status of the claims is as follows:

- all 112 rejections have been withdrawn against the claims. Art rejections are maintained; i.e., claims 37-50 are finally rejected using Seppanen or Umeda et al..

Furthermore, the Examiner objects to the "history" of prosecution (i.e., indication of earlier allowable claims, etc.) which appears to be an attempt to introduce an *argument* or *allusions* and is irrelevant as it relates to "*Status of Claims*".

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is substantially correct. However, the Examiner objects to the "history" of

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prosecution which appears to be argumentative in nature (i.e., "...*the Examiner found the arguments presented therein unpersuasive...*"), introduces allusions and is irrelevant as it relates to "*Status of Amendments After Final*".

(5) Summary of Invention

The summary of invention contained in the brief is not fully agreed with for the following reasons. Appellants have not specifically mapped the claims to the "*Summary of the Invention*". MPEP section 1200 recites, in part:

Summary of Invention. A concise explanation of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. Where applicable, it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

Furthermore, the Examiner objects to the recitation which appears to be argumentative in nature (i.e., last three lines, page 3, Appeal Brief), introduces allusions and is irrelevant as it relates to "*Summary of the Invention*".

(6) Issues

The appellant's statement of the issues in the brief is not agreed with for the following reasons.

- the listing of the various issues is not agreed with because it relies on a grouping of claims which is not agreed with. The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with. Section 1200 provides guidance:

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(7) Grouping of Claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone, unless a statement is included that the claims of the group do not stand or fall together and, in the argument section of the brief (37 CFR 1.192(c)(8)), appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable. The absence of such a statement and argument is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them. 37 CFR 1.192(c)(7) is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); and *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). 37 CFR 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c)(8) (iii)). In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as "ABCDE" and "ABCDF". The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7). It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

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Appellants have never previously argued the claims as other than a single group. Please refer to pages 9-29, paper # 22. Appellants also refer to a single group in the Statement of the "Issues" (pp. 4-6, Appeal Brief). Furthermore, Appellants have not provided or presented any rationale or explanation for their grouping in the sections entitled "Grouping of Claims" or in "Arguments". In the "Arguments" section, Appellants have essentially only *recited the prior art teaching* followed by a *recitation of the claims* without pointing out the *patentable distinction*. Therefore, the Examiner considers the claims as a *single group*.

The correct statement of the issues (noting that *the 112(2) rejections have been withdrawn against claims 41-50*) is:

Claims 37-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Umeda et al. (U. S. Patent 5,544,348 - of record) or Seppanen (IEEE, 1993 - of record).

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with for the following reasons.

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with. Section 1200 provides guidance (*see earlier recitation*).

Appellants have never previously argued the claims as other than a single group. Please refer to pages 9-29, paper # 22. Appellants also refer to a single group in the Statement of the "Issues" (pp. 4-6, Appeal Brief). Furthermore, Appellants have provided not presented any rationale or explanation for their grouping in the sections entitled "Grouping of Claims" or in "Arguments". In the "Arguments" section, Appellants have essentially only *recited the prior art*

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teaching followed by a *recitation of the claims* without pointing out the *patentable distinction*.

Therefore, the Examiner considers the claims as a *single group*.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record *relied upon in the rejection* of claims under appeal.

5,544,348

Umeda et al.

8-1996

Seppanen, M.S. "Kanban Simulator using Siman and Lotus 1-2-3." Winter

Simulation Conference Proceedings 1993 (December, 1993), pp. 838-844.

The following is a listing of the prior art of record considered *cummulative* and *not applied* in the rejection of claims under appeal.

De Toni et al. "An Artifical, Intelligence-Based Production Scheduler"

Integrated Manufacturing Systems, (July, 1996), pp. 17-25.

Liberatore et al. "Dynamic Allocation of Kanbans in a Manufacturing System

Using Pertubation Analysis." Proc. ETFA '95 (October, 1995), pp. 595-603.

Jain et al. "Expert Simulation for On-Line Scheduling." Winter Simulation

Conference Proceedings (December, 1989), pp. 930-935.

Umeda "A Manufacturing-Oriented Simulation Package to Support Systems

Planning and its Operation." 1992 Winter Simulation Conference Proceedings

(December, 1992), pp. 890-898.

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Harmonsky "Simulation-Based Real-Time Scheduling: Review of Recent Developments." 1995 Winter Simulation Conference Proceedings (December, 1995), pp. 220-225.

Marriot "Production Scheduling Systems Using Provisa" 1994 Winter Simulation Conference Proceedings (December 1994), pp. 522-526.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 37-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Umeda et al. (U. S. Patent 5,544,348 - of record) or Seppanen (IEEE, 1993 - of record).

Umeda et al. teaches simulation of a Kanban system. See entire disclosure and particularly: abstract; figs. 1-15; col. 1, lines 42-55; col. 3, lines 48-67; col. 3, lines 1-48; col. 10 lines 1-67; col. 18, lines 10-67.

Seppanen teaches: "Kanban Simulator using Siman and Lotus 1-2-3." See particularly: abstract; and pp. 838-844.

(11) Response to Argument

A few introductory remarks are first presented. These remarks relate to various themes relating to general allegations of an improper examination that Appellants have attempted to develop in the Appeal Brief and which are interleaved throughout the Appeal Brief.

1) Appellants have misinterpreted passages from the MPEP. Appellants repeatedly state (see Appeal Brief: pp. 13-14, pp. 15-16) that:

"Appellant notes that this is not a proper §112, second paragraph rejection, which would address indefiniteness. MPEP §2172.01, which is cited in the Office Action for authority, exclusively

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addresses §112, first paragraph rejections. Accordingly, Applicant is uncertain what the Office Action is stating, thereby making this rejection confusing, and accordingly this rejection is improper, and should not be sustained."

In contrast, MPEP §2172.01 recites:

"2172.01 Unclaimed Essential Matter

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention."

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)."

2) **Application of the best prior art**: Appellants have complained that (pp. 19-21, Appeal Brief) the Examiner should only apply the best prior art, and concludes that the 102 rejections should therefore not be sustained. This appears to be the first time Appellants have raised this issue. First, the Examiner respectfully points out that Appellants have previously responded to all the rejections without complaint. Second, the Examiner only applied a few of many possible rejections, and in fact has only applied the *best art*, against Appellant's claims. Appellants assertions are *conclusory* in the lack of credible *evidence* to the contrary. As per 37 C.F.R. 1.104 (c), referred to on pg. 20 of the Appeal Brief, Appellants have not offered arguments that either the references are complex or that the pertinence of each reference is not apparent. Examiner does not believe this application raises to the level of "complex" especially knowing Applicants' and Assignees' relative level of experience in the field (note the co-pending appeal brief). The Examiner respectfully submits that it is late in

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the process to be raising this issue. The Examiner also notes that the Examiner had previously requested that Appellants supply any prior art of which they are aware a (see paragraphs 1-2, paper # 21) as per indications of such art in the specification (page 2 and first paragraph, page 3). *Appellants have not acknowledged or responded to said request.*

3) Omissions of Facts that Improperly Characterize the Record: Appellants have referred to the Examiner's rejection in such a manner as to improperly characterize the record. For example, see pg. 29, first full paragraph. In building support for the allegation that the Examiner has not provided "specificity", Appellants recite "See particularly ... list of references." Appellants' follow this up with the conclusion that "*Referring to a list of references is NOT a showing of specificity within the reference*". However, the conclusion is based on omission of facts that improperly characterize the record.

Compare this recitation with the *complete rejection* (paragraph 15, paper # 21), "*Corbett et al. disclose a review of papers concerning simulations of scheduling systems, including Kanban systems. See particularly: abstract; sections 2-3, and list of references.*" Appellants have ignored the emphasis on the portions which Appellants have omitted, namely, the *abstract* and *sections 2-3*. In point of fact, the Examiner had directed Appellants' attention to the list of references in an attempt to point out to Appellants the abundance of research in the art.

4) Appellants' reference to a supposed acknowledgement by the Examiner (Appeal Brief: page 28, second paragraph; page 44, second paragraph). This is *hearsay*. The Examiner has made no such statement and Appellants are asked to withdraw said allegation or provide *evidence* of such an acknowledgement by the Examiner. *The Representative was provided the courtesy of a two-hour interview in an attempt to resolve the outstanding issues in the co-pending applications and objects to such mischaracterization.*

In fact, the Examiner did repeatedly attempt (*during the interview and throughout prosecution of the instant application*) to impress upon Appellants that the claims were broad and,

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as such, were disclosed in the prior art. The Examiner also repeatedly attempted to suggest allowable material, namely details of the simulator, as disclosed in the specification.

5) **Allegations that the Examiner has misinterpreted the invention:** Appellants have also complained that the Examiner has misinterpreted the invention and conclude that the 102 rejections should not be sustained (Pg. 21, for example). The Examiner respectfully disagrees. The Examiner interprets the invention to be: *real-time (in the specification - but not claimed) optimization of a production routing schedule using stored feedback data as input to a simulator*. The Examiner also interprets *electronic/virtual Kanban* to be electronic tracking of items in a manufacturing line. These concepts have been disclosed in the prior art. Appellants have referred to their Summary of the Invention. However, Appellants have not explained the *patentable difference* between the *claim and said interpretation*. The Examiner respectfully does not see the patentable distinctions as per Appellants definitions (in the specification) of claimed features. Furthermore, as noted, *the Summary is not agreed with by the Examiner for reasons presented earlier*.

6) **Allegations that the Examiner has attempted to introduce extra references, not of record, into the rejections:** Appellants further allege that the Examiner has not responded a request that the “*extra references*” be supplied and addressed individually. These allegations appear on pg. 19 ((iii) 35 U.S.C. §102); pg. 22 ((iii)(1) 35 U.S.C. §102); pg. 27 ((iii)(5) 35 U.S.C. §102); pg. 43 ((iii)(17) 35 U.S.C. §102); ; pg. 46 ((iii)(19) 35 U.S.C. §102). Appellants are referring to references which themselves refer to other references (such as “Review” papers, journal papers, conference papers and *issued patents*). The Examiner *responded to the request* relating to this issue. Please see paper # 23 (Advisory Action) in which the Examiner stated that he was not aware of any legal basis for Appellants’ position. The Examiner respectfully submits that the issue can be simply analyzed by addressing the elements of 102 (a) and 102 (b). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Consider the "De Toni et al." reference. This is a description in a printed publication in this or a foreign country, before the invention thereof (i.e., 1996) by the applicant for a patent.

- Consider the "Corbett et al." reference. This is a *description in a printed publication in this or a foreign country* and was printed in 1993 - *more than one year prior to Appellants' date of application for patent in the united States.*

- Consider the "Harmonosky et al." reference. This is a *description in a printed publication in this or a foreign country* and was printed in 1995 - *more than one year prior to Appellants' date of application for patent in the united States.*

- Consider the "Krishnamurthi et al." reference. This is a *description in a printed publication in this or a foreign country* and was printed in 1993 - *more than one year prior to Appellants' date of application for patent in the united States.*

The publications in question meet the criteria as required under 35 U.S.C. 102 as recited above.

7) Allegations regarding improper or deficient examination: These allegations are presented or alluded to throughout the entire Appeal Brief): Applicants have generally not actually addressed the *merits* of the prior art rejections. Applicants appear to focus on whether certain phrases are present in the prior art, and on attempts to render the rejections somehow procedurally deficient (see, for example, pp. 19-21); the important issue is whether the prior art has previously disclosed Applicant's *invention*.

In response to these statements and Applicants' statement that the art did not *anticipate* or *render obvious* and allegations that in someway the prior office action was defective in asserting of

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the prior art against the claims, Examiner can only respond by stating the Applicants are presumed to be at least one(s) of ordinary skill in the art (note the *co-pending appeal brief*) and therefore should understand the prior art teachings as they apply to the claims at hand. The 102 rejections were intentionally structured to recite *anticipated*.

MPEP explicitly states: “A **prima facie** case of unpatentability is established when the information compels a conclusion that a claim is **unpatentable under the preponderance of evidence**, burden-of-proof standard, giving each term in the claim its **broadest reasonable construction consistent with the specification**, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability” and “An application should not be allowed, unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it “strictly adhere” to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The **standard** to be applied in all cases is the “**preponderance of the evidence**” test. In other words, **an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable** and “In rejecting claims for want of novelty or for obviousness, the **examiner must cite the best references at his or her command**. When a reference is *complex* or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, *if not apparent*, must be clearly explained and each rejected claim specified”. Examiner does not believe this application raises to the level of “complex” especially knowing Applicants’ and Assignees’ relative level of experience in the field (note the co-pending appeal brief).

Anticipation is a question of fact. *In re King*, 801 F.2d 324, 231 USPQ 136 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir.

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1983), *cert. denied*, 465 U.S. 1026 (1984), it is only necessary for the claims to " 'read on' something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it." Where, as here, a reference describes a class of compositions, the reference must be analyzed to determine whether it describes a composition(s) with sufficient specificity to constitute an anticipation under the statute. See *In re Schaumann* 572 F.2d 312, 197 USPQ 5 (CCPA 1978). (reciting from: *Ex parte Lee*, BPAI at 31 USPQ2d 1105)

The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that *the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it*. See Black's Law Dictionary 1071 (5th Ed. 1979). See generally *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing cases showing the evolution of the concept in patent examination of *prima facie* obviousness as a legal inference drawn from uncontradicted evidence) (reciting from *In re Spada* (CAFC) 15 USPQ2d 1655 (8/10/1990)). Especially in view of the fact that the courts have held that "A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sase*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

Prima facie means at first sight, on the first appearance, on the face of it, so far as can be judged from the first disclosure, presumably or a fact presumed to be true unless disproved by some evidence to the contrary. *Prima facie case is made when such will prevail until contradicted and overcome by other evidence or which has proceeded upon sufficient proof to that stage where it will support finding if evidence to the contrary is disregarded.* (recited from: Black's Law Dictionary, 5th Edition) A *prima facie* case can be made by the Examiners' assertion of the prior art associated with the pending claims that would render the claims unpatentable. As to the allowability or patentability of Applicants' claimed invention, only a "preponderance of the

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evidence” needs to be applied to make the determination of the allowability or patentability of pending claims. The Examiner notes that Applicants *have not shifted the burden to the Examiner in response the prima facie showing*.

Consider the arguments (for example, pages 43-45) against the 102 Harmonosky rejection:

- a) Appellants opine that *a review paper can not be used as prior art* (pp. 43) and conclude that the 102 rejection was improper;
- b) Appellants argue that a review paper “*does not disclose or teach anything*” (pg. 44);
- c) Appellants *inaccurately attribute admissions to the Examiner* (pg. 44);
- d) Appellants resort to a *conclusory statement* which is based on 1-3, above (i.e., “*Accordingly...*” - pg. 44, second paragraph);
- e) the *only possible argument of substance* begins in the second full paragraph (pg. 44, second paragraph) wherein Appellants refer to specific words in the claims. However, Appellants have not actually discussed the disclosure of Harmonosky or pointed out the patentable distinction between the disclosure in Harmonosky and the claims;
- f) Appellants argue that the Examiner has not shown specificity and concludes that the rejection is improper. Appellants are reminded that the Examiner did make a *prima facie showing*.

The Examiner will now address Appellants’ *remaining* arguments which are *germane* to the 102 rejections (*those which are not germane will be linked to the preceding discussion*).

Response to Arguments - 102- pp. 19-49

Appellants’ arguments relating to the prior art have been fully considered but they are not persuasive.

Consider claim 41, which is exemplary. Claim 41 recites (pg. 52, Appeal Brief):

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“A method for controlling a manufacturing production line using a virtual kanban system, the method comprising the steps of:

storing production line feedback data in a database;

inputting said feedback data into a production scheduling model that includes the virtual kanban system and generating an electronic kanban;

inputting the electronic kanban and the feedback data to a simulator and simulating the manufacturing production line;

determining the validity of the electronic kanban;

wherein the feedback data comprises a first data set specifying a type of equipment in the production line and a second data set specifying at least one of operating status of equipment, product lot status and production inputs status.”

Note that there is no connection between the claimed invention and a real manufacturing system.

- The production line feedback data could be hypothetical. There is no limitation specifying that the data was measured or obtained as it occurred.
- There is no output from the simulator to a manufacturing system.
- A manufacturing system has not been claimed.
- Nothing is actually done with the results (after determining validity of the kanban).

Note that nothing is being *controlled*. Such a feature is simply not claimed.

For these reasons, the Examiner's position has been that Appellants are disclosing (*in the specification*) *real-time optimization of a production routing schedule using feedback as input to a simulator*. The Examiner also interprets *electronic/virtual Kanban to be electronic tracking of items in a manufacturing line*. As per “validity” of the kanban, it is noted that Appellants

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refer (pg. 16, last paragraph, *Appeal Brief*), to lines 5-20 pg. 5 of the specification as it relates to “*determining validity of the Kanban.*” The Examiner respectfully submits that said portion does not disclose anything relating to “*determining validity of the Kanban.*” However, a reasonable interpretation is that “*validity*” refers to the existence of a simulation solution that could be implemented. In any case, these concepts been disclosed in the prior art. Note, however, that Appellants have not even claimed “*real-time*” in claim 41. Examiner has attempted to point out to Appellants that any disclosure regarding simulation of a Kanban system would read on the independent claims *as they have been drafted*. The claims, as recited, merely claim a simulation - any art regarding simulation of a Kanban would therefore read on the claims. *This was precisely the reason for the numerous 102 rejections.*

In response to applicant's arguments, the recitation *controlling a manufacturing process* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, in response to applicant's argument that “*Applicant is not claiming a simulation of a Kanban system...*” (pg. 10, paper # 17), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use,

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then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). **Functionally, Applicant has merely claimed a simulator of a production line schedule which uses stored feedback data in its simulation.**

Also note Applicants statement (second paragraph, pg 23, Appeal Brief), recited for convenience:

“The simulator of De Toni is **NOT** the simulator recited in claims 23 and 41, which simulates operation of the production line and receives as input the electronic kanban from the production scheduling model.”

Note that this states that the production line is simulated. It further states that the input comes from a model, not real data. ***In other words, Appellants only claiming a simulation of a production line which inherently includes simulation of tracking of manufacturing items and machines.*** Appellants also appear to be arguing or implying that the model is somehow separate from the simulation. The Examiner, respectfully, is not persuaded by such reasoning. It is inherent in simulations that the simulator must be initialized before it can be run. The “input” from the *model* is the *initialization* of the *simulation*. **The Examiner respectfully does not see the patentable distinction between Appellants claimed invention and the simulation of a kanban system.**

Note that the Examiner interprets claim 41 as follows (taking into account the above discussions):

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“A method for simulating a production line which uses an electronic tracking system, the method comprising the steps of:

storing production line feedback data in a database;

inputting said feedback data into a production scheduling model that includes the electronic tracking system and generating electronic data about the tracked items;

inputting the electronic item tracking data and the feedback data to a simulator and simulating the manufacturing production line;

determining if a solution to the simulation exists;

wherein the feedback data comprises a first data set specifying a type of equipment in the production line and a second data set specifying at least one of operating status of equipment, product lot status and production inputs status.”

Umeda et al. teaches simulation of a Kanban system. See entire disclosure and particularly: abstract; figs. 1-15; col. 1, lines 42-55; col. 3, lines 48-67; col. 3, lines 1-48; col. 10 lines 1-67; col. 18, lines 10-67.

Col. 18, lines 10-67, in particular, disclose “Simulation of a push/pull mixed type production order system,” and expressly denote it by *Kanban* (col. 18). Note Table 6 in col. 18.

Seppanen teaches: “*Kanban Simulator using Siman and Lotus 1-2-3.*” See particularly: abstract; and pp. 838-844.

Appellants arguments against both Umeda et al. (Page 24, Appeal brief) and Seppanen (page 25, Appeal Brief) suggest that they do not disclose determining the validity of the

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Kanban. The Examiner's position has been that Appellants are disclosing (*in the specification*) *real-time optimization of a production routing schedule using feedback as input to a simulator*. The Examiner also interpreted, *in the absence of information to the contrary*, that *electronic/virtual Kanban to be electronic tracking of items in a manufacturing line*. As per "validity" of the kanban, it is noted that Appellants refer (*pg. 16, last paragraph, Appeal Brief*), to lines 5-20 pg. 5 of the specification as it relates to "*determining validity of the Kanban*." The Examiner respectfully submits that said portion does not disclose anything relating to "*determining validity of the Kanban*." *However, a reasonable interpretation is that "validity" refers to the existence of a Kanban simulation solution that could be implemented*. The Examiner has consistently rejected the claims with this interpretation. Appellants now object to the interpretation but *have provided no information to the contrary*.

Prima facie case is made when such will prevail until contradicted and overcome by other evidence or which has proceeded upon sufficient proof to that stage where it will support finding if evidence to the contrary is disregarded.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dr. Hugh Jones

Primary Patent Examiner

October 5, 2003

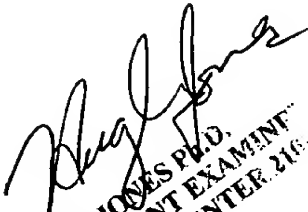
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